

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/262,077 03/04/99 TAKANASHI H 1497/FPTOK16

IM62/0920

WENDEROTH LIND & PONACK  
2033 K STREET NW  
SUITE 800  
WASHINGTON DC 20006

EXAMINER

LEE, S

ART UNIT

PAPER NUMBER

1752

12

DATE MAILED:

09/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
09/262,077

Applicant(s)

Takanashi et al.

Examiner

Sin J. Lee

Group Art Unit

1752

 Responsive to communication(s) filed on Jun 30, 2000 This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 6-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 6-9 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1752

1. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pine (4,361,640).

Pine teaches instant inventions of claims 6-9 except for explicitly disclosing the claimed range of 0.001 to 0.3 weight % for the amount of the compound having the formula (I) and the claimed range of 0.45 to 0.8 mm in thickness for the photosensitive layer. See particularly col.1, lines 20-23, lines 61-68, col.2, lines 1-23, lines 27-33, col.4, lines 20-27, lines 39-47, lines 58-62, lines 67-68, col.5, lines 1-15, col.6, lines 25-29.

With respect to claim 6, Pine teaches in col.4, lines 20-27 that a plasticizer can be present in his composition in amounts of 0 to 18% by weight, and he names mixed o,p-toluene sulfonamides as one of the six (not too many to choose from) useful plasticizers. Ortho or para toluene sulfonamides correspond to the applicants' component (E) having the formula (I) wherein -X represents  $-SO_2NHR^2$ . Therefore, it would have been obvious for one ordinarily skilled in the art to use the ortho or para toluene sulfonamides in the amount of 0 to 18% by weight since it is clearly taught in Pine. Also, in the case "where the [claimed] ranges overlap or lie inside ranges disclosed by the prior art," a *prima facie* case of obviousness would exist which may be overcome by a showing of unexpected results, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). As to the presently claimed thickness of the photosensitive layer, Pine teaches that layers within the range of 0.254 to 6.35 mm of thickness will be used for the majority of his printing plates (col.4, lines 39-47). Since this range overlaps with the presently claimed range of

Art Unit: 1752

0.45 to 0.8 mm, the prior art range would have made the presently claimed range *prima facie* obvious, In re Wertheim, supra.

With respect to claim 7, since Pine teaches the limitation of present claim 6 and since the mixed o,p-toluene sulfonamides have the boiling point of about 214°C, Pine teaches the present invention of claim 7.

2. As previously indicated in Advisory Action mailed on June 22, 2000, applicants' experiment for the Declaration filed on June 5, 2000 has been considered but it does not overcome the rejection because the composition used in the experiment does not include the thermal polymerization inhibitor (component (D)) which is an essential component for the present invention. Therefore, the comparison is not commensurate in scope with the broadest claim. Also, the composition includes additional components (such as trimethylolpropane, NH<sub>4</sub>OH, cupferron, and phosphoric acid) which are not found in the prior art, Pine '640. Therefore, the comparison was not made to the closest prior art. See particularly, MPEP 716.02(d), 716.02(e). Also, the Examiner would like to remind applicants that in order to establish unexpected results over the claimed range (in the present case, 0.001 - 0.3 wt% of the component (E)), applicants should compare sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range.

3. **This is a continuation of applicant's earlier Application No. 09/262,077. All claims are drawn to the same invention claimed in the earlier application and could have been**

Art Unit: 1752

**finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is (703) 305-0504. The examiner can normally be reached on Monday-Friday from 8:30 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for after final responses or (703) 305-7718 for all other responses.

Art Unit: 1752

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

*S.A.L.*

S. Lee

September 18, 2000

*JANET BAXTER*  
JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700